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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/821,615	03/29/2001	Ervin Dennis Walter	29794/36547A	4103
4743	7590	02/23/2006	EXAMINER	
MARSHALL, GERSTEIN & BORUN LLP 233 S. WACKER DRIVE, SUITE 6300 SEARS TOWER CHICAGO, IL 60606			GILLIGAN, CHRISTOPHER L	
			ART UNIT	PAPER NUMBER
			3626	

DATE MAILED: 02/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary**Application No.**

09/821,615

Applicant(s)

WALTER ET AL.

Examiner

Luke Gilligan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 December 0905.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Response to Amendment

1. In the amendment filed 12/9/05, the following has occurred: claims 1, 5, 7-12, 14, 16, 21-23, 29, and 42 have been amended and claims 45-54 have been added. Now, claims 1-54 are presented for examination.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-5, 8-27, 30-46, 49-50, and 53-54 are rejected under 35 U.S.C. 102(e) as being anticipated by Ilsen et al., U.S. Patent No. 6,757,898.

4. As per claim 1, Ilsen teaches a system for providing a patient with access to a shared health record for that patient, the system comprising; a patient health record system including a machine readable media having a data structure, the data structure containing patient-created data (see column 11, lines 39-43 and column 12, lines 13-15, the Examiner is interpreting the 'Web server' to be a form of patient health record server as recited); a communication network coupling the patient health record system with a patient interface, the patient interface providing the patient with access to the patient health record system via the communication network (see column 11, line 64 – column 12, line 10); wherein the patient health record system is adapted to securely be coupled in real-time to an enterprise health record system for providing access by the patient health record server to patient-related data for the patient retained within the

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enterprise health record system (see column 20, lines 19-37, the Examiner is interpreting the other aspects of the ePPi system to be a form of enterprise health record system as recited); wherein, via the patient interface, the patient may access the patient health record system for at least one of viewing, creating, or manipulating the patient-created data and for accessing the patient-related data from the enterprise health record system (see column 20, lines 52-67).

5. As per claim 2, Ilsen teaches the system of claim 1 as described above. Ilsen further teaches the communication network comprises the Internet and wherein the patient interface comprises a web browser (see column 12, lines 13-15).

6. As per claim 3, Ilsen teaches the system of claim 2 as described above, wherein the patient interface further comprises a personalized patient home page (see column 20, lines 52-67).

7. As per claim 4, Ilsen teaches the system of claim 1 as described above. Ilsen further teaches the communication network is adapted for securely exchanging messages between the patient and the enterprise health record system (see column 5, lines 36-43).

8. As per claim 5, Ilsen teaches the system of claim 4 as described above. Ilsen further teaches the messages comprise messages of the type comprising: a request for medical advice, a request for prescription renewal, a request for a referral, a customer service request, a request for a pre-qualified appointment and a request for an appointment (see column 4, lines 52-56).

9. As per claim 8, Ilsen teaches the system of claim 1 as described above. Ilsen further teaches the communication network comprises a security service, the security service being adapted to prohibit unauthorized access to the patient-created data and the patient-related data via the communication network (see column 12, lines 30-34 and column 13, lines 50-62).

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10. As per claim 9, Ilsen teaches the system of claim 1 as described above. Ilsen further teaches the system is adapted to receive a scheduling ticket from the enterprise health record system and to communicate the scheduling ticket to the patient, the scheduling ticket enabling the patient to schedule an appointment with a healthcare provider in accordance with an authorization provided by the scheduling ticket (see column 15, lines 48-51, the vaccination message is taken to be a form of scheduling ticket since it leads to an appointment request with the appropriate doctor).

11. As per claim 10, Ilsen teaches the system of claim 1 as described above. Ilsen further teaches the patient health record system is coupled to a source of information, the patient health record server including a relevancy engine for selecting patient-specific health-related information and for displaying that information to the patient via the patient interface (see column 15, line 65 – column 16, line 11).

12. As per claim 11, Ilsen teaches the system of claim 1 as described above. Ilsen further teaches the patient health record system is adapted to receive payment information from the patient via the patient interface and to communicate the payment information to the enterprise health record system (see column 19, lines 7-14, in this described embodiment in which the patient is communicating with an insurance case manager, clearly, the patient would need to communicate some sort of payment information).

13. As per claim 12, Ilsen teaches the system of claim 1 as described above. Ilsen further teaches the enterprise health record system is configured to provide view only access to the patient-related information (see column 33, lines 38-40).

14. As per claim 13, Ilsen teaches the system of claim 1 as described above. Ilsen further teaches the patient-related information comprises one of the group of patient-related information types comprising those listed in the claim (see column 20, lines 53-67).

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15. As per claim 14, Ilsen teaches the system of claim 1 as described above. Ilsen further teaches the patient health record system is adapted to receive messages from the patient via the patient interface and to forward the messages to the enterprise health record system (see column 8, lines 24-36).

16. As per claim 15, Ilsen teaches the system of claim 14 as described above. Ilsen further teaches the messages comprises one of the group of message types comprising: an appointment request, a medical advice request, a medication renewal request, a customer service message and an address change (see column 8, lines 24-36).

17. As per claim 16, Ilsen teaches the system of claim 14 as described above. Ilsen further teaches the patient health record system is adapted to receive a self-service access authorization for a patient from the enterprise health record system and to forward the self-service access authorization to the patient via the patient interface (see column 15, lines 48-51, also see interpretation noted above with respect to claim 9).

18. As per claim 17, Ilsen teaches the system of claim 16 as described above. Ilsen further teaches the self-service access authorization comprises one of the group of self-service access authorization types comprising: an option to schedule an appointment, an option to enroll in a health education class and an option to make credit card payments (see column 15, lines 48-51).

19. As per claim 18, Ilsen teaches the system of claim 1 as described above. Ilsen further teaches the patient created data comprises one of unstructured information and structured information (see column 20, lines 43-67).

20. As per claim 19, Ilsen teaches the system of claim 1 as described above. Ilsen further teaches the patient-created data comprises one of the group of data entry types comprising: a

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medication list, a health reminder list, a medical history summary, an immunizations list, an allergies list and a current health issues list (see column 20, lines 53-67).

21. As per claim 20, Ilsen teaches the system of claim 1 as described above. Ilsen further teaches the patient-created data comprises one of clinical information and administrative information (see column 20, lines 53-67).

22. As per claim 21, Ilsen teaches the system of claim 1 as described above. Ilsen further teaches the patient health record system is adapted to receive an information flag from the patient via the patient interface and to associate the information flag with one of the patient-created information and the patient-related information (see column 33, lines 25-28, the Examiner is broadly interpreting the patient submission of a form to be a form of 'information flag' as recited in the claim).

23. As per claim 22, Ilsen teaches the system of claim 21 as described above. Ilsen further teaches the patient health record system is further adapted to send an alert to the enterprise health record system upon receipt of an information flag (see column 33, lines 25-28, the Examiner is broadly interpreting the sending of an email alert to be a form of the recited 'alert').

24. Claims 23-27 and 30-44 contain substantially similar method limitations to system limitations 1-5 and 8-22 and, as such, are rejected for similar reasons as given above.

25. As per claim 45, Ilsen teaches the system of claim 1 as described above. Ilsen further teaches one or more components of the system for providing a patient with access to the shared health record for that patient are implemented on a server (see column 12, lines 13-15)

26. As per claim 46, Ilsen teaches the system of claim 45 as described above. Ilsen further teaches the server is at least one of the types of computers listed (see column 12, lines 13-15).

27. As per claim 49, Ilsen teaches the system of claim 1 as described above. Ilsen further teaches the communication network couples the patient health record system with the patient

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interface via at least one of bi-directional or uni-directional connection (see column 12, lines 13-15).

28. As per claim 50, Ilсен teaches the system of claim 1 as described above. Ilсен further teaches the patient health record system is adapted to be securely coupled in real time to the enterprise health record system via at least one of bi-directional or uni-directional connection (see column 20, lines 19-36).

29. As per claim 53, Ilсен teaches the system of claim 8 as described above. Ilсен further teaches the security service is implemented on a server (see column 12, lines 30-34 and column 13, lines 50-62).

30. As per claim 54, Ilсен teaches the system of claim 53 as described above. Ilсен further teaches the server is at least one of the types of computers listed (see column 12, lines 30-34 and column 13, lines 50-62).

Claim Rejections - 35 USC § 103

31. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

32. Claims 6 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ilсен, U.S. Patent No. 6,757,898 in view of Athing et al., U.S. Patent No. 5,987,498.

33. As per claim 6, Ilсен teaches the system of claim 1 as described above. Although Ilсен teaches a server that contains and permits view of patient-related data and that is coupled to the enterprise health record system as described above, the reference does not explicitly teach a shadow server that contains a copy of the data and permits viewing of the data. Athing

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teaches a network communication system comprising a plurality of servers that perform certain similar functions to those in Ilsen and that each server includes a respective shadow server to maintain and provide access to a copy of data contained on the main server (see column 5, line 44 – column 6, line 1). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into the system of Ilsen. One of ordinary skill in the art would have been motivated to incorporate this feature for the purpose of providing a safeguard against the failure of a primary server (see column 5, lines 64-66 of Athing). To enhance the ability of providing round-the-clock access to the ePPi system services as is indicated as desirable by Ilsen (see column 9, lines 57-60).

34. Claim 28 contains substantially similar method limitations to system claim 6 and, as such, is rejected for similar reasons as given above.

35. Claims 7, 29, and 51-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ilsen, U.S. Patent No. 6,757,898 in view of Rost, U.S. Patent No. 6,725,200.

36. As per claim 7, Ilsen teaches the system of claim 1 as described above. Although Ilsen teaches a server that prohibits unauthorized access to patient created and patient related data as described above, the reference does not explicitly teach prohibiting copying of the patient created data or the patient related data from the respective patient health record server and the enterprise health record system. Rost teaches a personal data archive system that includes the feature of prohibiting copying of personal health data from a storage device (see column 8, lines 54-62). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into the system of Ilsen. One of ordinary skill in the art would have been motivated to incorporate this feature for the purpose of enhancing the security of sensitive data in the system of Ilsen by preventing data misuse (see column 3, lines 27-29 of Rost).

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37. Claim 29 contains substantially similar method limitations to system claim 7 and, as such, is rejected for similar reasons as given above.

38. As per claim 51, Ilsen in view of Rost teach the system of claim 7 as described above. Ilsen further teaches a security service is implemented on a server (see column 12, lines 30-34 and column 13, lines 50-62).

39. As per claim 52, Ilsen in view of Rost teach the system of claim 51 as described above. Ilsen further teaches the server is at least one of the types of computers listed (see column 12, lines 30-34 and column 13, lines 50-62).

40. Claims 47 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ilsen, U.S. Patent No. 6,757,898 in view of Reid, U.S. Patent No. 6,233,616.

41. As per claim 47, Ilsen teaches the system of claim 1 as described above. Ilsen does not explicitly teach the system further includes a shadow server. Reid teaches an enterprise record management system that provides access to client devices through the use of a shadow server (see column 4, lines 39-46). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate such a feature into the system of Ilsen. One of ordinary skill in the art would have been motivated to incorporate such a feature for the purpose of enhancing security and directory services in the enterprise network of Ilsen (see column 2, lines 20-29 of Rost).

42. As per claim 48, Ilsen teaches the system of claim 1 as described above. Ilsen does not explicitly teach the enterprise health record system further includes a shadow server. Reid teaches an enterprise record management system that provides access to client devices through the use of a shadow server (see column 4, lines 39-46). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate such a feature into the

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system of Ilsen. One of ordinary skill in the art would have been motivated to incorporate such a feature for the purpose of enhancing security and directory services in the enterprise network of Ilsen (see column 2, lines 20-29 of Rost).

Response to Arguments

43. In the remarks filed 12/9/05, Applicant argues in substance that (1) Ilsen teaches away from the type of invention created by the inventors; (2) mapping of codes to content is substantially different from allowing access to an actual patient health record; (3) the existence of a sweeper program and mapping are evidence that Ilsen is not integrated to an actual enterprise health record system; (4) the Ilsen system is not coupled in real-time and cannot be real-time; (5) Ilsen does not provide real-time access to a shared health record.

44. In response to Applicant's argument (1), the Examiner respectfully submits that the portions of Ilsen cited by Applicant do not indicate that Ilsen teaches away from the claimed. Rather the Background of Ilsen describes problems with certain back office solutions such as those that have been provided in the past by such vendors as Epic. However, Applicant has failed to show how the "problems" described by Ilsen correlate to the claimed limitations. In fact, Applicant asserts that the present invention is designed to overcome the problems and hurdles described by Ilsen (see page 13 of the Remarks). Therefore, it is unclear to the Examiner how the comments in the Background of Ilsen show that the reference teaches away from the claimed invention.

45. In response to Applicant's argument (2), it is noted that the only specific mention of a patient health record is in the preamble of the claims. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness

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but, instead, the process steps or structural limitations are able to stand alone. See *In re Hiraio*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Instead, the body of the claims refer to providing access to “patient-created data” and “patient-related data.” However, even if the claims did recite that a patient is provided access to a patient health record, it is unclear how this would distinguish over the system of Ilsen in which a patient is provided with access to a plurality of patient-specific data (i.e. patient health record).

46. In response to Applicant’s argument (3), it is unclear to the Examiner what limitations correspond to this assertion. The Examiner respectfully submits that Figure 7 of Ilsen clearly shows an integrated enterprise health record system. Therefore, the Examiner does not find this argument to be persuasive.

47. In response to Applicant’s argument (4), it is respectfully noted that the term “real-time” is only limiting the term “coupled” as recited in the claims. Ilsen teaches a plurality of means for coupling the system (see column 11, lines 24-33) that can be used for “real-time” transactions. Since the claims do not recite any elements of real-time processing, transmitting, transaction, etc., it is respectfully submitted that the means for coupling described in Ilsen are a form of “real-time” coupling as recited in the claims. It is further noted that there is no mention in Ilsen of batch processing, such as once-a-day batches, contrary to what has been asserted by Applicant.

48. In response to Applicant’s argument (5), as noted above, the term “real-time” is only limiting the term “coupled” as recited in the claims. There is clearly no limitation that indicates real-time access to a shared health record is provided. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

49. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

50. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

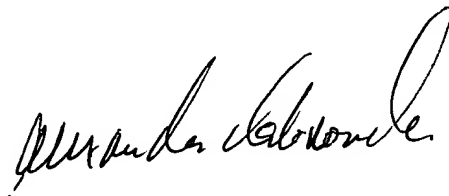
51. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luke Gilligan whose telephone number is (571) 272-6770. The examiner can normally be reached on Monday-Friday 8am-5:30pm.

52. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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53. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


CLG
2/16/06



**ALEXANDER KALINOWSKI
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